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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/143,343 08/28/98 BOYS

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CENTRAL COAST PATENT AGENCY
PO BOX 187
AROMAS CA 95004

EXAMINER

TRAN, T

ART UNIT

PAPER NUMBER

2615

DATE MAILED:

08/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/143,343

Applicant(s)

BOYS, MARK A.

Examiner

Thai Tran

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-4 and 17-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1, 18-20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Sprague ('645).

Regarding claim 1, Sprague discloses an apparatus for retroactive recording using memory of past information in a data storage buffer having an input port (40 of Fig. 3, col. 3, lines 42-53) for accepting data from the media presentation device; at least one recording mechanism (82 of Fig. 3, col. 3, lines 42-53) associated with at least one data store facility for recording and optional transfer of the recorded media for store; a user interface (14, 16, 18, 20, 22, 24, 26, 28, 30 and 32 of Fig. 2, col. 3, lines 23-35 and col. 4, lines 45-64 and col. 6, lines 9-59) for controlling functions of data transfer, store, and playback of recorded data; and a user input (col. 3, lines 23-35 and col. 4, lines 45-64 and col. 6, lines 9-59) on the user interface for inserting a flag set into the recorded data, the flag-set searchable and usable as indicia for beginning and/or ending

a playback session or for selecting a data portion of the recorded data for permanent storage.

Regarding claim 18, Sprague discloses a method for retroactive recording using memory of past information in a data storage buffer having the steps of (a) initiating perpetual recording of the presented media (col. 3, lines 23-35); (b) identifying a specific media selection during media presentation (col. 3, lines 23-63); (c) activating a flag-set indicia from a user interface on the perpetual recording device (col. 4, lines 45-64 and col. 6, lines 9-59); (d) activating a recover indicia from the user interface of step (c), the recover operation for retrieving the flagged media (col. 4, lines 45-64 and col. 6, lines 9-59); and (e) initialing playback or media store of the flagged media (col. 4, lines 45-64 and col. 6, lines 9-59).

Regarding claim 19, Sprague also discloses wherein in step (a), the recording is digital (col. 3, lines 42-53).

Regarding claim 20, Sprague further discloses wherein in step (c) the flag-set marks the beginning and end of a desired block of media (col. 4, lines 45-64 and col. 6, lines 9-59).

Regarding claim 22, Sprague discloses wherein in step (d) the indicia is a memory button that searches for the set flags automatically (col. 4, lines 45-64 and col. 6, lines 9-59).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2615

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sprague ('645) in view of Ichinose ('569).

Sprague discloses all the features of the instant invention as discussed in claim 18; however, Sprague does not specifically discloses wherein in step (d) the indicia is a jogging wheel manually operated to search the flag-sets.

Ichinose teaches a video editing viewer having a jogging wheel (6 of Fig. 1, col. 2, lines 14-39) for selecting an editing point.

It would have been obvious to one of ordinary skill in the art at the time of the invention to the rotary knob 6 of Ichinose into Sprague's system in order to facilitate the processing of searching the flag-sets.

5. Claims 2-4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sprague ('645) in view of Moe ('430).

Regarding claim 2, Sprague discloses all the features of the instant invention as discussed in claim 1 above except for providing wherein the media presentation device comprises one of an RF radio or a television.

Moe teaches a recovery recorder system having AM/FM stereo radio receiver (col. 6, line 65 to col. 7, line 30).

It is noted that Sprague teaches in col. 8, lines 52-59 that "although the foregoing embodiments of the invention describe the storage and retroactive playback of audio information received from a microphone, a retroactive recorder in accordance with the

present invention may also be configured to retroactively record video from a camera or data from other types of sensors, constituting any other type of information, such as serial data". Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the AM/FM stereo radio receiver as taught in Moe into Sprague's system in order to retroactively record the audio signal of the AM/FM stereo radio receiver or since it merely amounts to selecting an alternative equivalent input device.

Regarding claim 3, Sprague discloses an analog to digital converter, and wherein the at least one data store is a writeable digital memory accepting data writes comprising digitally recorded media (col. 4, lines 19-35).

Regarding claim 4, the combination of Sprague and Moe discloses that the flag-set denotes one of a complete song, or a block of completed songs (col. 4, lines 45-64 and col. 6, lines 9-59 of Sprague and col. 6, line 65 to col. 7, line 30 of Moe).

Regarding claim 17, Sprague discloses wherein coupling results in internalizing the device into the circuitry of the media presentation device (Fig. 1).

6. Claims 1-4, 17-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moe ('430) in view of Sprague ('645).

Regarding claim 1, Moe discloses a recovery recorder system having an input port (73-74 of Fig. 7) for accepting data from the media presentation device; at least one recording mechanism (80 of Fig. 7) associated with at least one data store facility for recording and optional transfer of the recorded media for store; and a user interface (Fig. 6) for controlling function of data transfer, store, and playback of recorded data.

However, Moe does not specifically disclose a user input on the user interface for inserting a flag set into the recorded data, the flag-set searchable and usable as indicia for beginning and/or ending a playback session or for selecting a data portion of the recorded data for permanent storage.

Sprague teaches in an apparatus for retroactive recording having a user input on the user interface for inserting a flag set into the recorded data, the flag-set searchable and usable as indicia for beginning and/or ending a playback session or for selecting a data portion of the recorded data for permanent storage (col. 4, lines 45-64 and col. 6, lines 9-59) so that the number of minutes into the past which can be selected by the user is determined by the size of the memory.

It would have been obvious to one of ordinary skill in the art at the time of the invention to the capability of inserting a flag set into the recorded data, the flag-set searchable and usable as indicia for beginning and/or ending a playback session or the selecting a data portion of the recorded data for permanent storage as taught by Sprague into Moe's system in order to facilitate the selection of the recording start time which can be retroactive and can be either the present time or a past point by selecting the number of minutes into the past.

Regarding claim 2, Moe discloses wherein the media presentation device comprises one of an RF radio or a television (col. 6, line 65 to col. 7, line 30).

Regarding claim 3, Moe and Sprague disclose an analog to digital converter, and wherein the at least one data store is a writeable digital memory accepting data writes

comprising digitally recorded media (col. 7, lines 35-62 of Moe and col. 4, lines 19-35 of Sprague).

Regarding claim 4, the combination of Sprague and Moe discloses that the flag-set denotes one of a complete song, or a block of completed songs (col. 4, lines 45-64 and col. 6, lines 9-59 of Sprague and col. 6, line 65 to col. 7, line 30 of Moe).

Regarding claim 17, Moe and Sprague disclose wherein coupling results in internalizing the device into the circuitry of the media presentation device (Fig. 6 of Moe and Fig. 1 of Sprague).

The method claim 18 is rejected for the same reasons as discussed in the recording device claim 1 above.

Regarding claim 19, Moe and Sprague also disclose wherein in step (a), the recording is digital (col. 7, lines 35-62 of Moe and col. 4, lines 19-35 of Sprague).

Regarding claim 20, Sprague further discloses wherein in step (c) the flag-set marks the beginning and end of a desired block of media (col. 4, lines 45-64 and col. 6, lines 9-59).

Regarding claim 22, Sprague discloses wherein in step (d) the indicia is a memory button that searches for the set flags automatically (col. 4, lines 45-64 and col. 6, lines 9-59).

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moe ('430) in view of Sprague ('645) as applied to claim 18 above, and further in view of Ichinose ('569).

The combination of Moe and Sprague discloses all the features of the instant invention as discussed in claim 18 except for providing that in step (d) the indicia is a jogging wheel manually operated to search the flag-sets.

Ichinose teaches a video editing viewer having a jogging wheel (6 of Fig. 1, col. 2, lines 14-39) for selecting an editing point.

It would have been obvious to one of ordinary skill in the art at the time of the invention to the rotary knob 6 of Ichinose into Sprague's system in order to facilitate the processing of searching the flag-sets.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

TTQ
August 23, 2001


THAI TRAN
PRIMARY EXAMINER